

**REMARKS**

In the Office Action dated March 20, 2006, the Examiner objected to claims 1 and 18 because of an asserted informality, rejected claims 1-19 under 35 U.S.C. § 112, second paragraph, rejected claims 1-19 under 35 U.S.C. § 101 as being purportedly directed to non-statutory subject matter, rejected claims 1-11 and 13-19 under 35 U.S.C. § 102(e) as being anticipated by Orpaz et al. (U.S. Patent No. 6,937,755); and rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Orpaz et al. in view of Lambertsen (U. S. Patent Application No. 2002/0024528).

Applicant has amended claims 1, 3, and 18. Applicant has also added new claims 20 and 21. Support for these claim amendments and new claims can be found in applicant's specification, for example, on pages 13, 17-19, and 50. Claims 1-21 are pending in this application.

**I. Objection of Claims 1 and 18**

Applicant has amended claims 1 and 18, without narrowing their scope, to recite “wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template, and wherein the simulation of the displayed facial portion corresponds to a simulation of the at least one selected template.” Applicant respectfully submits that amended claims 1 and 18 do not contain any asserted informality. Therefore, Applicant requests that the objection to claims 1 and 18 be withdrawn.

**II. Rejection of Claims 1-19 under 35 U.S.C. § 112, second paragraph**

Applicant has amended claim 1 to recite “a method of enabling display of a simulated facial image” and claim 18 to recite “a method of enabling viewing display of a simulated facial image.” Therefore, the Section 112, second paragraph, rejection with regard to the term “beauty analysis” is moot since the claim no longer recites that term.

The Examiner asserts on page 3 of the Office Action that the terms “enabling selection” and “facilitating display” are purportedly indefinite, and the the “examiner does not understand how said ‘enabling selection’ and ‘facilitating display’ steps differ from ‘selecting’ and ‘displaying’ steps. Applicants direct the Examiner’s attention to the specification, for example, at page 35, paragraph 115 through page 36, paragraph 116, at page 38, paragraph 124, and at page 50, paragraph 153, which include disclosure relating to the meaning of the terms “enabling . . .” and “facilitating . . . .” Based on at least this description, one of ordinary skill in the art would understand the meaning of the “enabling selection” and “facilitating display” recitations.

For at least these reasons, Applicant respectfully requests the Examiner to withdraw the rejection of claims 1-19.

**III. Rejection of Claims 1-19 under 35 U.S.C. § 101**

On page 4 of the Office Action, the Examiner asserts that claims 1-19 are purportedly non-statutory because they are “nothing more than presenting information to a consumer.” Applicant respectfully disagrees. Claims 1-19 are directed to statutory subject matter because they include recitations that produce a “concrete, tangible and useful” result and, therefore, recite a practical application that is not abstract.

According to the Federal Circuit, whether a claim is statutory focuses on “the essential characteristics of the subject matter, in particular, its practical utility.” *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d at 1375. If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. See *State Street*, 149 F.3d at 1373, *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Circ. 1999), also cited in M.P.E.P. § 2106(II)(A).

In this case, claims 1-17, for example, relate to a method for enabling display of a simulated facial image. These claims clearly recite features that produce a useful, concrete, and tangible result. The claimed “facilitating display . . . of a plurality of templates,” “enabling selection of at least one of the displayed templates,” and “facilitating display . . . of a simulated facial image,” provide a useful, concrete, and tangible result in the form of, for example, a simulated facial image that includes one or

more displayed facial portions having a simulation of use of a beauty product. This is a result that can be used in beauty analysis (specification, page 3).

Further, the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” issued on October 26, 2005, indicate, “[i]n determining whether the claim is for a ‘practical application,’ the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result is “useful, tangible and concrete.” In this application, for example, “facilitating display . . . of a simulated facial image including at least one displayed facial portion having a simulation of use of a beautify product,” as recited in claim 1, is undeniably useful, and constitutes a tangible and concrete final result. Further, such a result facilitates display of a simulated facial image and enables a beauty analysis.

For at least the foregoing reasons, claims 1-19 are statutory under 35 U.S.C. § 101. Applicant thus requests that the Examiner withdraw the rejection of claims 1-19 under 35 U.S.C. § 101.

#### **IV. Rejection of Claims 1-11 and 13-19 under 35 U.S.C. § 102(e)**

In order for Orpaz et al. to anticipate Applicant's claims under 35 U.S.C. § 102(e), each and every element of the claim at issue must be found, either expressly or under principles of inherency, in the reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)).

Orpaz et al. fails to anticipate claims 1 and 18 because Orpaz et al. does not disclose, expressly or otherwise, each and every feature recited in claims 1 and 18. For example, Orpaz et al. does not disclose "facilitating display, on a display device, of a plurality of templates . . .; enabling selection of at least one of the displayed templates; and facilitating display . . . of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template," as recited in claim 1. Further, Orpaz et al. does not disclose viewing display, on a display device, of a plurality of templates . . .; selecting at least one of the displayed templates; and viewing display . . . of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product, wherein the displayed facial portion of the simulated facial image corresponds to a facial portion of the at least one selected template," as recited in claim 18.

In the Office Action, the Examiner cites column 6, line 20 to column 7 line 13 of Orpaz et al. for the asserted disclosure of certain subject matter. Applicant respectfully disagrees with this interpretation of Orpaz et al.

Orpaz et al. is directed to a method for simulating an appearance of make-up and fashion accessories on an image. (Abstract). In the Orpaz et al. system, a user selects a product from a database using an image simulation interface. (Col. 6: 61-63). "To simulate the appearance of the selected product on the base image of the user, the color information of the selected product is modified and blended according to the color information of the base image to create a composite image." (Col. 6: 66 - Col. 7:3). For each base image, one or more make-up application areas are defined for each make-up

product type and are assigned a separate alpha channel within the base image file. (Col. 5: 66-Col. 6:2). The Examiner has apparently attempted to equate FIGs. 12-18, which are the alpha values for various makeup application areas, with the claimed "templates." (Office Action, page 5).

Contrary to the Examiner's apparent assertions, the portions of Orpaz et al. cited by the Examiner relate to a user selecting a product and simulating the appearance of the product. Nothing in Orpaz et al. discloses, e.g., facilitating display of a plurality of templates, enabling selection of at least one displayed template, and facilitating display of a simulated facial image including at least one displayed facial portion corresponding to a facial portion of the at least one selected template, as recited in claim 1. For example, Orpaz et al. does not have any disclosure relating to facilitating display of any of FIGs. 12-18 or enabling selection of one or more of FIGs. 12-18. Therefore, Orpaz et al. fails to teach each and every element of claim 1. Moreover, although claim 18 has a scope different from that of claim 1, Orpaz et al. also does not disclose each of the features of claim 18.

Applicant therefore respectfully requests the Examiner to withdraw the 35 U.S.C. § 102(e) rejection of claims 1 and 18, and claims 2-12, 13-17, and 19 at least by virtue of their dependence from claims 1 and 18, respectively.

**V. Rejection of Claim 12 under 35 U.S.C. § 103(a)**

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Here, the cited references cannot support a rejection under 35 U.S.C. § 103(a) because, among other things, Orpaz et al. and Lambertsen, taken alone or in any proper combination, do not disclose, teach, or suggest each and every feature recited in Applicant's claims 1 and 18. In particular, Lambertsen does not overcome the above-noted shortcomings of Orpaz et al.

The Examiner cites Lambertsen for the asserted disclosure of "selecting at least one of a size and a shape for at least one of a head, eyes, nose, lips, ears, and eyebrows." (Office Action, page 8). However, Lambertsen does not disclose or suggest "facilitating display, on a display device, of a plurality of templates . . .; enabling selection of at least one of the displayed templates; and facilitating display . . . of a simulated facial image including at least one displayed facial portion having a simulation of use of a beauty product," as recited in claim 1. Nor does the Examiner assert that Lambertsen disclose such features.

Accordingly, Orpaz et al. and Lambertsen, taken along or in any proper combination, do not teach or suggest each and every feature recited in Applicant's independent claim 1, and, therefore, cannot support a rejection of this claim or dependent claim 12 under 35 U.S.C. § 103(a).

Moreover, new claims 20 and 21 depend from claims 1 and 18, respectively, and thus should be allowable for at least the same reasons claims 1 and 18 are allowable.

**VI. Conclusion**

Applicant submits that the claims are allowable over the cited references.


Applicant, therefore, requests the Examiner's reconsideration of the application, and the timely allowance of claims 1-21.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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